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Date: November 21, 2007/Kimberly Webb/
Kimberly Webb**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re patent application of:

Applicant(s): Teresa Martineau, *et al.*

Examiner: Mark A. Fadok

Serial No: 09/698,379

Art Unit: 3625

Filing Date: October 27, 2000

Title: WISH LIST

**Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

APPEAL BRIEF

Dear Sir:

Appellants' representative submits this brief in connection with an appeal of the above-identified patent application. A payment *via* credit card is filed concurrently herewith in connection with all fees due regarding this appeal brief. In the event any additional fees may be due and/or are not covered by the credit card, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1063 [MSFTP151US].

I. Real Party in Interest (37 C.F.R. §41.37(c)(1)(i))

The real party in interest in the present appeal is Microsoft Corporation, the assignee of the present application.

II. Related Appeals and Interferences (37 C.F.R. §41.37(c)(1)(ii))

Appellants, appellants' legal representative, and/or the assignee of the present application are not aware of any appeals or interferences which may be related to, will directly affect, or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims (37 C.F.R. §41.37(c)(1)(iii))

Claims 12-40 have been withdrawn. Claims 1-11, 41-49 stand rejected by the Examiner. The rejection of claims 1-11, 41-49 is being appealed.

IV. Status of Amendments (37 C.F.R. §41.37(c)(1)(iv))

No amendments to the claims were submitted after the Final Office Action. (*See* Applicants' Reply to Final Office Action dated June 27, 2007).

V. Summary of Claimed Subject Matter (37 C.F.R. §41.37(c)(1)(v))**A. Independent Claim 1**

A system that facilitates electronic shopping through an electronic item list for items residing on the Internet comprising: an item database holding information with respect to items, the information is at least one of an offer type, a general product type, a specific manufacturer type and a specific merchant type; an item list database that stores an item list that includes a reference to at least one item associated with the information stored in the item database (*See e.g.*, page 2, lines 9-11; page 5, lines 26-30; page 6, lines 6-12); and an interface component that receives a request to display the item that is referenced in the item list, accesses the item list database to obtain the reference from the item list, utilizes the reference as a key into the item database, retrieves data corresponding to the referenced item from the item database, and utilizes the retrieved data to display the item and associated information to the requester (*See e.g.*, page 6, lines 13-30).

B. Independent Claim 41

A method that provides an electronic item list for items residing on the Internet comprising: providing an item database that stores information with respect to items, the information is at least one of an offer type, a general product type, a specific manufacturer type and a specific merchant type (*See e.g.*, page 2, lines 9-11; page 5, lines 26-30; page 6, lines 6-12); and storing an item list in an item list database, the item list includes a reference to an item associated with the information stored in the item database, the reference is utilized as a key into the item database to extract data corresponding to the referenced item from the item database and to display the referenced item and associated information (*See e.g.*, page 6, lines 13-30).

C. Independent Claim 47

A system that facilitates electronic shopping through an electronic item list for items residing on the Internet comprising: means for storing information with respect to items, the information at least one of an offer type, a general product type, a specific manufacturer type and a specific merchant type (*See e.g.*, page 2, lines 9-11; page 5, lines 26-30; page 6, lines 6-12); means for storing an item list that includes a reference to an item associated with the stored information (*See e.g.*, page 6, lines 13-30); and means for receiving a request to display the referenced item, retrieving the reference, utilizing the reference as a key into the stored information, extracting data corresponding to the referenced item and utilizing the extracted data to display the item and associated information to the requester (*See e.g.*, page 6, lines 13-30).

VI. Grounds of Rejection to be Reviewed (37 C.F.R. §41.37(c)(1)(vi))

A. Claims 1, 2, 5-7, 9-11, 41, 42 and 45-48 stand rejected under 35 U.S.C. §102(e) as being unpatentable over Lee (6,611,814).

B. Claims 3, 4, 43 and 49 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lee in view of Hsu (7,013,292).

C. Claim 6 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Lee in view of NetGift (a collection of articles and web pages).

VII. Argument (37 C.F.R. §41.37(c)(1)(vii))**A. Rejection of Claims 1, 2, 5-7, 9-11, 41, 42 and 45-48 Under 35 U.S.C. §102(c)**

Claims 1, 2, 5-7, 9-11, 41, 42 and 45-48 stand rejected under 35 U.S.C. §102(c) as being anticipated by Lee (6,611,814). This rejection should be reversed for the following reasons. Lee does not disclose or suggest each and every limitation set forth in the subject claims.

For a prior art reference to anticipate, 35 U.S.C. §102 requires that *“each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”* In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (quoting Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

Applicants’ claimed invention relates generally to creating an electronic shopping list (e.g., a list of references to items) for a user and utilizing this list to purchase items for the user over the Internet. (See Specification, page 2, lines 9-11). The systems and methods of the present invention provide a user interface that enables the user to create a personalized list of references to items (e.g., offers, product categories, products from merchants, products from manufacturers...) by electronically selecting and adding such items to their item list. (See Specification, page 2, lines 11-17). This list of references, as well as other users’ item lists, is stored within an item list database (See Specification, page 2, lines 17-18). Information related to items (e.g., offer, manufacturer and merchant information) is stored within one or more item databases. (See Specification, page 6, lines 7-17). In particular, independent claim 1 (and similarly independent claims 41 and 47), in part, recites *an item database holding information with respect to items, the information is at least one of an offer type, a general product type, a specific manufacturer type and a specific merchant type; an item list database that stores an item list that includes a reference to at least one item associated with the information stored in the item database.*

In general, an owner of an item list or a customer who intends on purchasing an item for owner of the item list can request the stored item list. On request, an interface component utilizes item references from the stored item list to extract related item data from the item

databases. The extracted data is employed to present a list of items to a requester ensuring that current item information from the item databases is provided. (See Specification, page 7, lines 5-10). In particular, independent claim 1 (and similarly independent claims 41 and 47), further recites *an interface component that receives a request to display the item that is referenced in the item list, accesses the item list database to obtain the reference from the item list, utilizes the reference as a key into the item database, retrieves data corresponding to the referenced item from the item database, and utilizes the retrieved data to display the item and associated information to the requester.* Lee fails to disclose or suggest such novel aspects of the claimed invention.

Lee merely discloses a system and a method for generating **virtual wish lists** for assisting shopping over computer networks. Lee discloses a system that provides for virtual wish lists, while not requiring the users to register to online stores for using the wish list service, and **not requiring the users to add products to buy to their wish lists.** (See, column 2, lines 59-64). Lee further discloses that “a virtual wish list 900 is automatically created, and it keeps information of product its owner is interested in by using the information collected from Web pages the person request and examines in the Internet.” (See column 6, lines 24-30). On the other hand, the claimed invention provides for a user interface that enables a **user to create a personalized list** of references to items (e.g., offers, product categories, products from merchants, products from manufacturers...) **by electronically selecting and adding such items** to their item list. It is therefore readily apparent that Lee teaches away from the claimed subject matter of a user requiring to add items to a wish list, as Lee’s system relates to a **virtual wish list**, which automatically creates a wish list from information collected from users’ web interaction.

Furthermore, Lee fails to disclose or suggest *an interface component that receives a request to display the item that is referenced in the item list, accesses the item list database to obtain the reference from the item list, utilizes the reference as a key into the item database and retrieves data corresponding to the referenced item from the item database and utilizes the retrieved data to display the item and associated information to the requester.* The use of references stored in an item list to extract information from an item database for display of an item provides several advantages. By utilizing references to items to extract items from the item database rather than simply copying the data into the item list database on a periodic basis, the system ensures that the displayed item information is current. Modifications to the item database

will be automatically reflected when the item lists are displayed to users. For example, if the price of an item is increased in an item database, the increased price will be automatically retrieved from the information database when item lists are displayed to users without requiring a separate update of effected item lists. Similarly if a particular item is not available, the information is automatically retrieved from the information database without requiring a separate update of effected item lists. Lee is completely silent with respect to utilizing any such *references to items to extract items from the item database* and therefore fails to provide an item list that has current product information. In fact, Lee discloses that: “sometimes it is possible that certain products in the shopping list (which uses the information from virtual wish list) are not available in the store 120 where the shopping list 1100 is submitted. Then the store 120 *may not* be able to *have entries for such products* the recommended product list 1200”. (See column 13, lines 41-46). In contrast, the claimed invention provides for an interface component that has the capability to degrade the data gracefully, such that the best available information within the databases is *always provided to the user*. For example, if an offer is not available any longer that is in a user’s item list, the interface component can then provide the user with a link to the merchant’s site or other items that may be similar to the listed item, such as items in a related product class or items in a related product category. If the merchant is not available any longer or the merchant no longer carries the item, the interface component can then provide alternative merchants that may sell the item. The interface component is further operable to provide additional information for the shopping portal during invocations of links to the interface component, such as displaying products and/or offers from requested categories, providing manufacturers for a requested product and merchants for a given manufacturer. (See Specification, page 7, lines 1-14). Such a technique is possible by utilizing *references to items to extract items from the item database*, instead of directly retrieving information from the database system. Therefore, it is readily apparent that Lee’s system which fails to employ references to items to extract items from the item database, suffers from the several advantage mentioned above.

Based on at least the foregoing, Lee fails to anticipate each and every element of the claimed subject matter as recited in independent claims 1, 41, and 49 (and claims which depend there from). Therefore, this rejection should be reversed.

B. Rejection of Claims 3, 4, 43 and 49 Under 35 U.S.C. §103(a)

Claims 3, 4, 43 and 49 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lee in view of Hsu (7,013,292). It is respectfully submitted that this rejection should be reversed for at least the following reasons. Lee and Hsu, individually or in combination, do not disclose or suggest each and every element set forth in the subject claims.

Hsu does not make up for the aforementioned deficiencies of Lee with respect to independent claims 1, 41 and 47 (which claims 3, 4, 43, and 49 depend there from). In particular, Hsu is silent with respect to *an item list database that stores an item list that includes a reference to at least one item associated with the information stored in the item database*, as recited in independent claim 1 (and similarly claims 41 and 47). Furthermore, Hsu fails to disclose or suggest *an interface component...to display the item that is referenced in the item list... utilizes the reference as a key into the item database, retrieves data corresponding to the referenced item from the item database...*, as recited in independent claim 1 (and similarly claims 41 and 47). Therefore, the claimed invention as recited in claims 3, 4, 43, and 49 is not obvious over the combination of Lee and Hsu. Thus, it is respectfully submitted that this rejection be reversed.

C. Rejection of Claim 6 Under 35 U.S.C. §103(a)

Claim 6 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Lee in view of NetGift (a collection of articles and web pages). It is respectfully submitted that this rejection should be reversed for at least the following reasons. Lee and NetGift, individually or in combination, do not disclose or suggest each and every element set forth in the subject claim. In particular NetGift does not make up for the aforementioned deficiencies of Lee with respect to independent claims 1 (which claim 6 depends there from). Therefore, the claimed invention as recited in claims 6 is not obvious over the combination of Lee and NetGift. Thus, it is respectfully submitted that this rejection be reversed.

D. Conclusion

For at least the above reasons, the claims currently under consideration are believed to be patentable over the cited references. Accordingly, it is respectfully requested that the rejections of claims 1-49 be reversed.

If any additional fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP151US].

Respectfully submitted,

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VIII. Claims Appendix (37 C.F.R. §41.37(c)(1)(viii))

1. A system that facilitates electronic shopping through an electronic item list for items residing on the Internet comprising:

an item database holding information with respect to items, the information is at least one of an offer type, a general product type, a specific manufacturer type and a specific merchant type;

an item list database that stores an item list that includes a reference to at least one item associated with the information stored in the item database; and

an interface component that receives a request to display the item that is referenced in the item list, accesses the item list database to obtain the reference from the item list, utilizes the reference as a key into the item database, retrieves data corresponding to the referenced item from the item database, and utilizes the retrieved data to display the item and associated information to the requester.

2. The system of claim 1, the interface component degrades the display of the item as records are removed from the item database.

3. The system of claim 1, further comprising a custom input component that allows a user to add a custom element to the item list, the custom element not residing in the item database.

4. The system of claim 3, further comprising a user interface component that receives data related to the custom element from a user, the data comprises at least one of structured and unstructured data.

5. The system of claim 1, further comprising a remote input component that allows a user to add an item to the item list, the item is a description that resides on a remote merchant's site, and the remote merchant site employs a link to the remote input component that invokes the remote input component.

6. The system of claim 5, the remote input component adds the description of the item to the item list, the description includes one of structured and unstructured data.
7. The system of claim 5, the description is linked to information associated with an item in the item database and the remote input component adds the linked information to the item list.
8. The system of claim 1, further comprising a component that links an infrastructure of the item list system to a remote site, the item list system appears to reside on the remote site.
9. The system of claim 1, the interface component comprises a plurality of ASP pages.
10. The system of claim 1, further comprising at least one HTML page that allows a user to select items from an electronic web-site to add to the item list and at least one element that provides a link from a selected item to the interface component, the interface component adds the selected item to the item list.
11. The system of claim 1, further comprising a gift finder component that is associated with the item list, the gift finder component accesses a user attribute database to retrieve attributes related to an owner of the item list, the gift finder component employs the retrieved attributes to extract data from the item database and returns at least one item based on the retrieved attributes.
12. A system that creates and maintains an electronic item list for items residing on the Internet comprising:
 - at least one database that stores information with respect to items; and
 - an interface component that receives a request for items in an item list, accesses the items from the at least one database and returns the requested item list, the interface component joins items from the at least one database and degrades the joined items as records are removed from any of the at least one database by providing other items from a same merchant that are similar to the removed items.

13. The system of claim 12, the items include data from at least two of an offer type, a general product type, a specific manufacturer type and a specific merchant type, the interface component degrades the joined items by providing the best information from data available in the at least two of a general product type, a specific manufacturer type and a specific merchant type.

14. A system that creates and maintains an electronic item list for items residing on the Internet comprising:

an item list database and at least one database with item information stored in records;
and

an interface component that receives a request to add an item, which is not in the at least one database, to an item list stored in the item list database, the item is associated with information that comprises structured data that conforms to a format of the records in the at least one database and unstructured data that does not conform to the format of the records in the at least one database or reside in the records in the at least one database.

15. The system of claim 14, further comprising a custom input component that allows a user to add a custom element to the item list, the custom element component comprises structured and unstructured data.

16. The system of claim 15, further comprising a user interface component that receives data related to a custom element from a user, the data comprises at least one of structured and unstructured data.

17. The system of claim 14, further comprising a remote input component that allows a user to add an item to the item list having a description residing on a remote merchant's site, the remote merchant site employs a link to the remote input component to invoke the remote input component.

18. The system of claim 17, the remote input component adds the description of the item to the item list, the description includes one of structured and unstructured data.

19. The system of claim 17, the description is linked to information associated with an item in the at least one database and the remote input component adds the information with respect to the item to the item list.
20. A system that creates and maintains an electronic item list for items residing at different merchant sites on the Internet comprising:
- a database that stores item lists;
 - at least one database that holds information with respect to items in a stored item list;
 - a component that adds an item to the item list, the item resides at a remote merchant site and is associated with information that neither conforms to the format of the records in the at least one database nor resides in the records in the at least one database; and
 - an interface component located at the remote site that receives a request for items in the item list and presents the items to appear that they reside at the remote site by removing items that are not located at the remote site.
21. The system of claim 20, the interface component filters the items in order to return only items related to the remote site.
22. The system of claim 21, the interface component accesses and returns only items related to the remote site based on an ID associated with the items.
23. The system of claim 21, the interface component accesses and returns only items related to the remote site by accessing and returning items on a separate list associated with items related to the remote site.
24. A system that creates and maintains an electronic item list for items residing on the Internet comprising:
- at least one database with saved information with respect to items in an item list that is stored in an item list database,

a user attribute database that stores user attributes and user preferences for an owner of the item list; and

a gift finder component that accesses the user attribute database and retrieves attributes associated with the owner of the item list, utilizes the attributes to query the at least one database, selectively extracts information associated with at least one item data from the at least one database based on the attributes, and displays the at least one item of interest to a purchaser.

25. The system of claim 24, the item list comprises a link associated with the gift finder component that invokes the gift finder component from the item list.

26. A method that provides an electronic item list for items residing on the Internet comprising:

providing at least one database that stores information with respect to items, the information is at least one of an offer type, a general product type, a specific manufacturer type and a specific merchant type;

providing an item list database that stores references to the items stored in the at least one database;

receiving a request from a requestor for at least one item associated with the information in the at least one database;

accessing the item list database for the references to the at least one item ;

extracting data from the at least one database that corresponds to the references; and
utilizing the extracted data to display the requested item list to the requestor.

27. The method of claim 26, further comprising joining the extracted data and degrading the joined items as records are removed from any of the at least one database.

28. The method of claim 26, further comprising joining structured and unstructured data.

29. The method of claim 26, further comprising inputting custom items into the item list database.

30. The method of claim 26, further comprising providing a link and a product description at a remote merchant site that allows a user to add items from a remote site to the item list database.
31. The method of claim 26, further comprising linking the infrastructure of the item list to a remote site, the item list appears to reside on the remote site.
32. The method of claim 26, further comprising providing links from selectable items on at least one HTML page, the links allow a user to select items from an electronic web-site to add to the item list.
33. A computer-readable medium having computer-executable instructions that perform the steps of claim 26.
34. A method that provides an electronic item list for items residing on the Internet comprising the steps of:
- providing at least one database that holds information with respect to items, the information is at least one of an offer type, a general product type, a specific manufacturer type and a specific merchant type;
 - providing a user attribute database that stores attributes with respect to an owner of the item list;
 - receiving a request from a requestor for possible gift items;
 - accessing the user attribute database for the attributes and preferences of the owner of the item list, the preferences include additional items of interest of the user that are not in the user's item list;
 - extracting data that corresponds to the at least one database based on the attributes and preferences;
 - degrading the extracted data as records are removed from any of the at least one database by providing other items from a same merchant that are similar to the removed items; and
 - displaying the items to the requestor.
35. A system that creates and maintains an electronic item list for items residing on the

Internet comprising:

means for storing information with respect to items, the information is at least one of an offer type, a general product type, a specific manufacturer type and a specific merchant type;

means for storing references to the items stored in the at least one database;

means for extracting data corresponding to the at least one database employing the stored references.

36. The system of claim 35, further comprising means for joining the extracted data and means for degrading the extracted data as records are removed from any of the at least one database.

37. The system of claim 35, further comprising means for providing custom input elements to the item list.

38. The system of claim 35, further comprising means for allowing a user to add an item residing on a remote merchant's site to the item list.

39. The system of claim 35, further comprising means for linking the infrastructure of the item list system to a remote site wherein the item list system appears to reside on the remote site.

40. The system of claim 35, further comprising means for providing gift suggestions to a receiver of an item list, the receiver employs attributes that reside in a user attribute database and means for extracting data from the at least one database based on the attributes.

41. A method that provides an electronic item list for items residing on the Internet comprising:

providing an item database that stores information with respect to items, the information is at least one of an offer type, a general product type, a specific manufacturer type and a specific merchant type; and

storing an item list in an item list database, the item list includes a reference to an item associated with the information stored in the item database, the reference is utilized as a key into

the item database to extract data corresponding to the referenced item from the item database and to display the referenced item and associated information.

42. The method of claim 41, further comprising degrading the display of the item as records are removed from the item database.

43. The method of claim 41, further comprising adding a custom element to the item list, the custom element not residing in the item database.

44. The method of claim 41, further comprising linking an infrastructure of the item list to a remote site such that the item list appears to reside on the remote site.

45. The method of claim 41, further comprising:
allowing a user to select an item from an electronic web-site to add to the item list; and
adding the selected item to the item list.

46. The method of claim 41, further comprising:
accessing a user attribute database to retrieve attributes related to an owner of the item list;
employing the retrieved attributes to extract data from the item database; and
returning the extracted data.

47. A system that facilitates electronic shopping through an electronic item list for items residing on the Internet comprising:

means for storing information with respect to items, the information at least one of an offer type, a general product type, a specific manufacturer type and a specific merchant type;

means for storing an item list that includes a reference to an item associated with the stored information; and

means for receiving a request to display the referenced item, retrieving the reference, utilizing the reference as a key into the stored information, extracting data corresponding to the

referenced item and utilizing the extracted data to display the item and associated information to the requester.

48. The system of claim 47, further comprising means for degrading the display of the item as records are removed from the stored information.

49. The system of claim 47, further comprising means for allowing a user to add a custom element to the item list, the custom element not residing in the stored information.

IX. Evidence Appendix (37 C.F.R. §41.37(c)(1)(ix))

None.

X. Related Proceedings Appendix (37 C.F.R. §41.37(c)(1)(x))

None.